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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/612,996	07/07/2003	Tommy Olaus Johnson	19903.0043	9812

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BINGHAM MCCUTCHEN LLP  
2020 K Street, N.W.  
Intellectual Property Department  
WASHINGTON, DC 20006

EXAMINER
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GELAGAY, SHEWAYE

ART UNIT	PAPER NUMBER
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2137

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/21/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

## Office Action Summary

**Application No.**

10/612,996

**Applicant(s)**

JOHNSON ET AL.

**Examiner**

Shewaye Gelagay

**Art Unit**

2137

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 07 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-60 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-60 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

1. Claims 1-60 have been examined.

***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 8-14, 28-34 and 48-54 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 8, 28 and 48 recite, "transferring the entire requested file ... to fulfill the request for data comprising a portion of the requested file." It is unclear how the entire requested file is transferred while the request is only for data comprising a portion of the requested file.
4. Claims 8, 28 and 48 recite the limitation "the entire requested file" in line 4. There is insufficient antecedent basis for this limitation in the claim.
5. Claims 9-14, 29-34 and 49-54 are rejected for being dependent on the rejected claims.

***Claim Rejections - 35 USC § 101***

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Art Unit: 2137

7. Claims 2-20, 22-40 and 42-60 are rejected for being dependent on the rejected claims.

8. Claims 41-60 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claim 41 is directed towards a computer program product on computer readable medium wherein the readable medium is not defined by the specification as being a storage medium. Applicant's specification on page 23, lines 3-6 teaches "Examples of computer readable media ... transmission-type media, such as digital and analog communications links". "Functional descriptive material consists of data structures and computer programs which impart functionality when employed as a computer component." The claims should be amended to specify that the computer readable medium is a storage medium.

9. Claims 42-60 are rejected for being dependent on the rejected claim.

***Claim Rejections - 35 USC § 102***

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Art Unit: 2137

11. Claims 1-6, 15-19, 21-26, 35-39, 41-46 and 55-60 are rejected under 35 U.S.C. 102(b) as being anticipated by Tso et al. (hereinafter Tso) US Patent 6,088,803.

As per claims 1, 21 and 41

Tso teaches a method of scanning a requested file for a computer malware comprising the steps of:

receiving a request to transfer a file from computer malware scanning software; (col. 2, lines 16-67)

receiving a request from the computer malware scanning software for data comprising a randomly accessed portion of the requested file; (col. 3, lines 10-54) and

transferring the requested portion of the file and supplying the requested data to the computer malware scanning software to fulfill the request for data comprising a portion of the requested file. (col. 3, lines 10-54)

As per claims 2, 22 and 42:

Tso teaches all the subject matter as discussed above. In addition, Tso further discloses a method wherein the request to transfer the file from the computer malware scanning software comprises a request to transfer the file from an external system. (col. 2, lines 22-25)

As per claims 3-4, 23-24 and 43-44:

Tso teaches all the subject matter as discussed above. In addition, Tso further discloses a method wherein the external system is communicatively connected via a network. (figure 1)

As per claims 5, 18, 25, 38, 45 and 58:

Art Unit: 2137

Tso teaches all the subject matter as discussed above. In addition, Tso further discloses a method wherein the step of transferring the requested portion of the file comprises the step of: initiating a session with the external system to obtain the requested portion of the file. (col. 2, lines 62-67)

As per claims 6, 19, 26, 39, 46 and 59:

Tso teaches all the subject matter as discussed above. In addition, Tso further discloses a method wherein the session is a hypertext transfer protocol session. (col. 2, lines 62-67)

As per claims 15, 35 and 55:

Tso teaches all the subject matter as discussed above. In addition, Tso further discloses a method comprising the step of: performing the steps of claim 1 in response to a request from a user system for the file. (col. 2, lines 16-67)

As per claims 16, 36 and 56:

Tso teaches all the subject matter as discussed above. In addition, Tso further discloses a method comprising the steps of: scanning at the computer malware scanning software the data comprising a portion of the requested file to determine if the file includes a computer malware; (col. 3, lines 10-54) and delivering the file to the user system in response to determining that the file does not include a computer malware. (col. 3, lines 38-65)

As per claims 17, 37 and 57:

Tso teaches all the subject matter as discussed above. In addition, Tso further discloses a method wherein the step of delivering the file to the user system comprises the steps of: determining whether the entire file has been transferred; (col. 3, lines 10-54) starting delivery of the file to the user system even if the entire file has not been transferred; (col. 3, lines 38-65) and transferring those portions of the file that have not been transferred and delivering those portions of the file once they have been transferred. (col. 3, lines 38-65)

***Claim Rejections - 35 USC § 103***

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 7-14, 20, 27-34, 40, 47-54 and 60 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tso et al. (hereinafter Tso) US Patent 6,088,803 in view of Moshir et al. (hereinafter Moshir) 6,990,660.

As per claims 7, 20, 27, 40, 47 and 60:

Tso teaches all the subject matter as discussed above. Tso does not explicitly disclose wherein the hypertext transfer protocol session uses a byte range technique. Moshir in analogous art, however, discloses wherein the hypertext transfer protocol session uses a byte range technique. (col. 29, line 30-col. 30,

Art Unit: 2137

line 67) Therefore it would have been obvious to one ordinary skill in the art to modify the method disclosed by Tso with Moshir in order to have a system that allows a client request to be divided into subranges according to various structural units. (col. 29, lines 32-35; Moshir)

As per claims 8, 28 and 48:

The combination of Tso and Moshir teaches all the subject matter as discussed above. In addition, Tso further teaches a method comprising the steps of: determining that the requested portion of the requested file cannot be transferred; (col. 2, line 62-col. 3, line 10) and transferring the entire requested file and supplying the requested data to the computer malware scanning software to fulfill the request for data comprising a portion of the requested file. (col. 2, line 62-col. 3, line 54)

As per claims 9, 29 and 49:

The combination of Tso and Moshir teaches all the subject matter as discussed above. In addition, Tso further teaches a method wherein the requested portion of the requested file cannot be transferred because the requested portion of the requested file cannot be randomly accessed. (col. 2, line 62-col. 3, line 54)

As per claims 10, 30 and 50:

The combination of Tso and Moshir teaches all the subject matter as discussed above. In addition, Tso further teaches a method wherein an indication that the requested portion of the requested file cannot be randomly accessed comprises an error indication or a transfer of the entire requested file. (col. 2, line 62-col. 3, line 54)

As per claims 11, 31 and 51:



Art Unit: 2137

The combination of Tso and Moshir teaches all the subject matter as discussed above. In addition, Tso further teaches a method comprising the steps of: tracking information associated with each transfer of a requested portion of the file; (col. 5, line 27-col. 6, line 24) and determining that information associated with the file has changed. (col. 5, line 27-col. 6, line 24)

As per claims 12, 32 and 52

The combination of Tso and Moshir teaches all the subject matter as discussed above. In addition, Moshir further teaches a method wherein the information associated with the file comprises hypertext transfer protocol entity tags or last modified timestamp information. (col. 30, lines 52-61)

As per claims 13, 33 and 53:

The combination of Tso and Moshir teaches all the subject matter as discussed above. In addition, Tso further teaches a method comprising the step of: restarting the requests from the computer malware scanning software for data. (col. 3, lines 10-54)

As per claims 14, 34 and 54:

The combination of Tso and Moshir teaches all the subject matter as discussed above. In addition, Tso further teaches a method comprising the step of: transferring the entire requested file. (col. 3, lines 2-10)

***Claim Rejections - 35 USC § 102***

Art Unit: 2137

14. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

15. Claims 1, 21 and 41 are rejected under 35 U.S.C. 102(e) as being anticipated by Makinson et al. (hereinafter Makinson) US Patent Number 7,023,861.

As per claims 1, 21 and 41

Makinson teaches a method of scanning a requested file for a computer malware comprising the steps of:

receiving a request to transfer a file from computer malware scanning software;  
(col. 2, lines 16-67)

receiving a request from the computer malware scanning software for data comprising a randomly accessed portion of the requested file; (col. 4, line 31-col.5, line 36) and

transferring the requested portion of the file and supplying the requested data to the computer malware scanning software to fulfill the request for data comprising a portion of the requested file. (col. 4, line 31-col.5, line 36)

### ***Conclusion***

Art Unit: 2137

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See Form PTO-892.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shewaye Gelagay whose telephone number is 571-272-4219. The examiner can normally be reached on 8:00 am to 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Emmanuel Moise can be reached on 571-272-3865. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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SUPERVISORY PATENT EXAMINER